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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,894	11/08/2001	Mutsuhiro Ohmori	112857-304	8737

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BELL, BOYD & LLOYD, LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER

CANGIALOSI, SALVATORE A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,894

Applicant(s)

OHMORI, MUTSUHIRO

Examiner

Salvatore Cangialosi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) 1-26,43-62,76 and 77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-42 and 63-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/21/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The restriction requirement dated 07/08/2005 is made final. The Group V without traverse is acknowledged and Group V is modified to include claim 41. Claims to the non-elected invention should be deleted. At that time the rejection on statutory basis of claims 27-39 will be moot.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

3. Claims 27-39 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts;
and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory

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subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the claimed code is non-functional descriptive data and therefore is not per se statutory.

4. The following is a quotation of 35 U.S.C. . 103, which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title; if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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5. Claims 40-42, 61, 63-75 are rejected under 35 U.S.C. . 103 as being unpatentable over Teper et al (5815665) or Sixtus (5903721) in view of Alcorn et al (6104815).

Regarding claim 40, Teper et al (See abstract, See Figs. 1-4, Col. 3, lines 5-65, and Cols. 5 and 6) or Sixtus (See abstract, Figs. 1, 2 and 5, Col. 3, lines 30-65, Col. 4, lines 1-65) disclose means for verification of a user by a first server (broker or trust server) to a second server (vendor) substantially as claimed. (Note that the vendor or service provider are nominally implemented by node servers in a digital network) The differences between the above and the claimed invention is the use of specific portable user device. It is noted that it is believed that ubiquitous cellular phones or PDA's are functionally equivalent to the claimed limitations and that the claim as drawn is readable on any the well established mobile users. Alcorn et al (See Figs. 1 and 6, Col. 9, lines 40-50) show portable user device including verification over a network. It is also noted that all portable network users employ some form of verification to connect to a network and employ challenge response for financial transactions. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Teper et al because the portable user devices are conventional functional equivalents with respect to the claim limitations and their employment is a necessary component of modern digital networks. Regarding the url limitations of claim 41, Teper et al (See abstract, See Figs. 1-4, Col. 3, lines 5-65,

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and Cols. 5 and 6) or Sixtus (See abstract, Figs. 1, 2 and 5, Col. 3, lines 30-65, Col. 4, lines 1-65) disclose means for verification of a user by a first server(broker or trust server) to a second server(vendor) which is a functional equivalent of the claim limitations because url is the common identifier in a digital network. Regarding the port limitations of claim 42, Alcorn et al (See Figs. 1 and 6, Col. 9, lines 40-50) show portable user device including verification over a network which is a functional equivalent of the claim limitations because ports are required for access to device input. Regarding the date limitations of claim 63, Teper et al(See abstract, See Figs. 1-4, Col. 3, lines 5-65, and Cols. 5 and 6) or Sixtus (See abstract, Figs. 1, 2 and 5, Col. 3, lines 30-65, Col. 4, lines 1-65) disclose means for verification of a user by a first server(broker or trust server) to a second server(vendor) which is a functional equivalent of the claim limitations because verification of financial transactions always include expiration dates. Regarding the server limitations of claim 64, Teper et al(See abstract, See Figs. 1-4, Col. 3, lines 5-65, and Cols. 5 and 6) or Sixtus (See abstract, Figs. 1, 2 and 5, Col. 3, lines 30-65, Col. 4, lines 1-65) disclose means for verification of a user by a first server(broker or trust server) to a second server(vendor) including a plurality of servers offering different services which is a functional equivalent of the claim limitations. Regarding the server limitations of claim 65, Teper et al(See abstract, See Figs. 1-4, Col. 3, lines 5-65, and Cols. 5 and 6) or Sixtus (See

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abstract, Figs. 1, 2 and 5, Col. 3, lines 30-65, Col. 4, lines 1-65) disclose means for verification of a user by a first server(broker or trust server) to a second server(vendor) which include standard computer elements which is a functional equivalent of the claim limitations. Regarding the device limitations of claim 66, Alcorn et al (See Figs. 1 and 6, Col. 9, lines 40-50) show portable user device including verification over a network and a plurality of processing elements which is a functional equivalent of the claim limitations. Regarding the server limitations of claim 67, Teper et al(See abstract, See Figs. 1-4, Col. 3, lines 5-65, and Cols. 5 and 6) or Sixtus (See abstract, Figs. 1, 2 and 5, Col. 3, lines 30-65, Col. 4, lines 1-65) disclose means for verification of a user by a first server(broker or trust server) to a second server(vendor) which include standard computer elements which is a functional equivalent of the claim limitations. Regarding the device limitations of claim 68, Alcorn et al (See Figs. 1 and 6, Col. 9, lines 40-50) show portable user device including verification over a network and a plurality of memory elements, which is a functional equivalent of the claim limitations. Regarding the server limitations of claims 69-73, Teper et al(See abstract, See Figs. 1-4, Col. 3, lines 5-65, and Cols. 5 and 6) or Sixtus (See abstract, Figs. 1, 2 and 5, Col. 3, lines 30-65, Col. 4, lines 1-65) disclose means for verification of a user by a first server(broker or trust server) to a second server(vendor) which include standard computer elements which is a functional

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equivalent of the claim limitations because the claims merely describe standard browser functionalities. Regarding claim 74, Teper et al (See abstract, See Figs. 1-4, Col. 3, lines 5-65, and Cols. 5 and 6) or Sixtus (See abstract, Figs. 1, 2 and 5, Col. 3, lines 30-65, Col. 4, lines 1-65) disclose means for verification of a user by a first server(broker or trust server) to a second server(vendor) substantially as claimed. (Note that the vendor or service provider are nominally implemented by node servers in a digital network) The differences between the above and the claimed invention is the use of specific portable user device. It is noted that it is believed that ubiquitous cellular phones or PDA's are functionally equivalent to the claimed limitations and that the claim as drawn is readable on any the well established mobile users. Alcorn et al (See Figs. 1 and 6, Col. 9, lines 40-50) show portable user device including verification over a network. It is also noted that all portable network users employ some form of verification to connect to a network and employ challenge response for financial trans actions. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Teper et al because the portable user devices are conventional functional equivalents with respect to the claim limitations and their employment is a necessary component of modern digital networks. Regarding the date limitations of claim 75, Teper et al (See abstract, See Figs. 1-4, Col. 3, lines 5-65, and Cols. 5 and 6) or Sixtus (See abstract, Figs. 1, 2 and 5, Col. 3, lines 30-65, Col. 4, lines 1-65) disclose means for

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verification of a user by a first server(broker or trust server) to a second server(vendor) which is a functional equivalent of the claim limitations because verification of financial transactions always include expiration dates.

Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number (571) 272-6927. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

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SALVATORE CANGIALOSI
PRIMARY EXAMINER
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